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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,974	08/10/2006	Shinichirou Omatsu	294866US3PCT	4629

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

FRANCIS, FAYE

ART UNIT	PAPER NUMBER
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3725

NOTIFICATION DATE	DELIVERY MODE
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02/08/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.		Applicant(s)	
	10/588,974		OMATSU ET AL.	
	Examiner		Art Unit	
	Faye Francis		3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-21 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: proper antecedent basis should be provided in the specification for the teaching that the axis of the cylindrical member intersects the part of the true circle or the oval, as now recited in claim 13. No new matter should be entered into the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to sufficiently describe the invention claimed in claim 1 so as to enable one of ordinary skill in the art to make the invention claimed without undue experimentation. It is not clear from the specification how the axis of the cylindrical member intersects the part of the true circle or the oval.

4. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e., New Matter.

The specification as originally filed does not provide support for the teaching of "the axis of the cylindrical member intersects the part of the true circle or the oval" as now recited in claim 13.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13-21 and 24-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is indefinite since all of the structure which the applicant considers to be encompassed by the phrase "the axis of the cylindrical member intersects the part of the true circle or the oval" cannot be determined.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 13-14,16-21 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnishi et al. (5,934,575), hereinafter Ohnishi in view of the applicant's admitted Prior Art in page 1 of the specification, hereinafter Prior Art.

Ohnishi discloses a process for preparing a toner comprising: pulverizing a resin composition with a jet type pulverizer comprising a nozzle and an impact member arranged so as to face the nozzle (Fig. 1), wherein the toner is prepared by melt-kneading a mixture containing a binder resin and a colorant or a magnetic powder, cooling the resultant kneaded product. The pulverization of the cooled product usually comprises crushing (or median pulverization) the cooled product by means of a mechanical impact pulverizer and subsequently finely pulverizing the crushed product by means of a pneumatic impact pulverizer making use of air-jet streams. Additionally, Ohnishi discloses the binder resin may include polystyrene; homopolymers of styrene substitution products, such as a styrene-acrylate copolymer, epoxy resins and xylene resins. In particular, styrene copolymers, polyester resins and epoxy resins are preferred resins. Also, for the purpose of improving the properties of toner, it is preferable to mix an external additive such as silica in toner particles.

Ohnishi may not disclose the impact member is a form of a part of a true circle or an oval.

Prior Art discloses that it is well known to provide a jet type pulverizer with an impact member which is a form of a part of a true circle. Therefore, it would have been obvious to modify the impact member in the device of Ohnishi to have a circular shape to improve the quality of the end product. Any remaining limitations not disclosed in the reference would then have been obvious design choice, as they solve no stated problem and of no patentable merit.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnishi in view of Prior Art as applied to claims 13-14 and 16-22 above and further in view of JP 200-140675, hereinafter JP'675.

Modified device of Ohnishi has most of the elements of this claim but for an inner side of the throat part forms a smooth, continuous arc starting from the inlet to the diffuser part.

JP'675 is cited to show desirability, in the relevant art, to provide the inner side of the throat part so that it forms a smooth, continuous arc starting from the inlet to the diffuser part (Fig. 3) in order to effectively ground the material. It would have been to further modify the throat part in the modified device of Ohnishi to have a smooth, continuous arc as taught by JP'675 in order to effectively ground the material.

Response to Arguments

11. Applicant's arguments filed 1/14/109 have been fully considered but they are not persuasive.

In response to applicant's argument on page 5 regarding the support found in Fig. 3, the examiner would like to point out that the description of Fig. 3 in the specification does not appear to be accurate not to mention confusing. For example, page 2 of the specification states "wherein r_1 is a radius of the largest circle R_1 among the circles formed with 3 points including any given 2 points located on the outer circumference of the impact side of the above impact member, and one point located on a line connecting the 2 points in the shortest distance on the impact side; and r_2 is a radius of the largest circle R_2 among the circles formed with 3 points including 2 points located on an outer circumference of the impact side, intersecting with a line perpendicularly at a given point with the line connecting the 3 points forming the circle R_1 , and one point located on a line connecting the 2 points in the shortest distance on the impact side; and a pulverization member and a jet type pulverizer, each being used in the process.". However, there is no r_1 in the drawing and R_1 appears to be straight line and not a circle.

In response to applicant's argument on page 7 regarding the combination of the references, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re Simon, 174 USPQ 114 (CCPA 1972); In re McLaughlin, 170 USPQ 209 (CCPA

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1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The question under 35 USC §103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989) and *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. *In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1905 (Fed. Cir. 1990); *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976); *In re Wilder*, 429 F.2d 447, 166 USPQ 545 (CCPA 1970). In this case, the artisan would have been motivated to modify the impact member in the device of Ohnishi to have a circular shape to improve the quality of the end product

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 571-272-4423. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Faye Francis/
Primary Examiner
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FF